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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* MICHAEL C. SCOGGIE,  
9 MICHAEL E. KACABA,  
10 DAVID A. ROCHON, and  
11 DAVID M. DIAMOND  
12

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14 Appeal 2008-004478  
15 Application 09/401,939  
16 Technology Center 3600  
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19 Decided: April 30, 2010  
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22 Before HUBERT C. LORIN, ANTON W. FETTING, and BIBHU R.  
23 MOHANTY, *Administrative Patent Judges*.  
24 FETTING, *Administrative Patent Judge*.

25  
DECISION ON APPEAL

STATEMENT OF THE CASE

Michael C. Scoggie, Michael E. Kacaba, David A. Rochon, and David M. Diamond (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 32-76, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION<sup>1</sup>

We AFFIRM-IN-PART.

THE INVENTION

The Appellants invented ways of delivering customer incentives and other shopping aids to customers with a computer network (Specification 1:6-8).

An understanding of the invention can be derived from a reading of exemplary claims 32 and 33, which are reproduced below [bracketed matter and some paragraphing added].

32. A computer implemented method for distributing purchasing incentives to consumers, comprising:

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<sup>1</sup> Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed May 20, 2008) and the Examiner's Answer ("Ans.," mailed February 27, 2007), and Final Rejection ("Final Rej.," mailed August 11, 2006).

- 1 [1] transmitting promotion data identifying a plurality of  
2 product discounts  
3 from a main computer  
4 to a personal computer  
5 over a computer network;  
6 [2] displaying said plurality of product discounts  
7 at said personal computer  
8 based on said promotion data;  
9 [3] transmitting selection data  
10 designating at least one product discount  
11 selected from said plurality of product discounts from  
12 said personal computer to said main computer  
13 over said computer network;  
14 [4] generating token data  
15 depending on said selection data;  
16 [5] transmitting said token data  
17 from said main computer  
18 to said personal computer  
19 over said computer network;  
20 [6] identifying said token data  
21 in a retail store  
22 in association with items being purchased at said retail  
23 store;  
24 [7] determining discount items being purchased  
25 corresponding to said at least one product discount from  
26 said identified token data; and  
27 [8] generating a purchase incentive  
28 based on said discount items.
- 29 33. The method of claim 32,

wherein generating said purchase incentive comprises  
generating an instantly redeemable voucher.

### THE REJECTIONS

The Examiner relies upon the following prior art:

Nichtberger	US 4,882,675	Nov. 21, 1989
Barnett	US 6,321,208 B1	Nov. 20, 2001

Claims 32, 33, 35-46, 48-59, 61-71, and 75 stand rejected under 35 U.S.C. § 102(b) as anticipated by Nichtberger.

Claims 34, 47, and 60 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Nichtberger.

Claims 72-74 and 76 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Nichtberger and Barnett.

### ARGUMENTS

*Claims 32, 33, 35-46, 48-59, 61-71, and 75 rejected under  
35 U.S.C. § 102(b) as anticipated by Nichtberger.*

Claims 32-44 are method claims; claims 45-57 are system claims; and claims 58-70 are computer media claims. Each of these sets generally parallels the other two, hence the Appellants argue the first set, and those arguments apply to the corresponding claims in the other sets as well. The Appellants argued independent claim 32, and dependent claims 33, 41, 42, and 44. They argue that Nichtberger does not describe using a personal computer (claim 32); a voucher (claim 33); a discount on the basis of usage frequency (claims 41 and 42); and an intranet or Internet (claim 44).

*Claims 34, 47 and 60 rejected under 35 U.S.C. § 103(a) as unpatentable  
over Nichtberger.*

The Appellants apply their argument regarding the lack of a voucher  
from claim 33 to claim 34 as well.

*Claims 72-74 and 76 rejected under 35 U.S.C. § 103(a) as unpatentable  
over Nichtberger and Barnett.*

The Appellants argue the Examiner has not shown any motivation to  
combine the references.

#### ISSUES

The issue of whether the Examiner erred in rejecting claims 32, 33, 35-  
46, 48-59, 61-71, and 75 under 35 U.S.C. § 102(b) as anticipated by  
Nichtberger turns on whether Nichtberger anticipates the claimed personal  
computer, voucher, usage frequency discount, and intranet.

The issue of whether the Examiner erred in rejecting claims 34, 47 and  
60 under 35 U.S.C. § 103(a) as unpatentable over Nichtberger turns on the  
resolution to the rejection of claim 33.

The issue of whether the Examiner erred in rejecting claims 72-74 and  
76 under 35 U.S.C. § 103(a) as unpatentable over Nichtberger and Barnett  
turns on whether it was predictable for one of ordinary skill to apply  
Barnett's to Nichtberger's system.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

*Facts Related to Claim Construction*

01. The disclosure contains no lexicographic definition of “personal computer.”

02. The ordinary and customary meaning of “personal computer” is a computer built around a microprocessor for use by an individual.<sup>2</sup>

03. The disclosure contains no lexicographic definition of “voucher.”

04. The ordinary and customary meaning of “voucher” is a piece of substantiating evidence.<sup>2</sup>

*Facts Related to the Prior Art*

*Nichtberger*

05. Nichtberger is directed to distribution, redemption and clearing of coupons and the like, and in particular how coupons (such as, cents-off merchandise coupons) can be distributed, redeemed and cleared electronically. (Nichtberger 1:6-11).

06. Nichtberger describes how a customer can select product discount promotions at a computer and then the selected

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<sup>2</sup> *American Heritage Dictionary of the English Language* (4<sup>th</sup> ed. 2000).

promotions are displayed at checkout during a sale. Nichtberger  
Summary Of The Invention: 1:58-2:6.

07. Nichtberger's computer used for discount selection is used by a  
customer (Nichtberger Coupon Distribution and Redemption  
Summary 10:50 – 11:45) and has a microprocessor as its  
computing unit (Block diagram of the computer in Nichtberger  
Fig. 5).

08. A receipt may be printed by Nichtberger for the user's  
convenience, identifying the selected coupons. Nichtberger: 5:15-  
16.

09. Nichtberger describes a communications link, but does not  
describe the topology or the protocols employed in the link.  
Nichtberger: 11:46-50.

*Barnett*

10. Barnett is directed to distributing and generating, at remote-site  
product redemption coupons. Barnett: 4:40-44.

PRINCIPLES OF LAW

*Anticipation*

"A claim is anticipated only if each and every element as set forth in the  
claim is found, either expressly or inherently described, in a single prior art  
reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628,  
631 (Fed. Cir. 1987). "When a claim covers several structures or  
compositions, either generically or as alternatives, the claim is deemed  
anticipated if any of the structures or compositions within the scope of the



claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

#### *Obviousness*

A claimed invention is unpatentable if the differences between it and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: "[ (1) ] the scope and content of the prior art are to be determined; [ (2) ] differences between the prior art and the claims at issue are to be ascertained; and [ (3) ] the level of ordinary skill in the pertinent art resolved." *Graham*, 383 U.S. at 17. *See also KSR*, 550 U.S. at 406. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR*, 550 U.S. at 416.

#### ANALYSIS

*Claims 32, 33, 35-46, 48-59, 61-71, and 75 rejected under 35 U.S.C.  
§ 102(b) as anticipated by Nichtberger.*

The independent claims essentially are for a customer to select product discount promotions at a personal computer and then the selected

1 promotions are displayed at checkout during a sale. Nichtberger does this  
2 with a computer (FF 06) and the Appellants do not dispute this. The sole  
3 argument is that Nichtberger's computer is not a personal computer because  
4 the Appellants contend that a personal computer must be personal to the user  
5 and have email and internet connections. Appeal Br. 18.

6 The Specification does not define a personal computer. FF 01. Both the  
7 Appellants and the Examiner offer constructions for consideration, but  
8 absent further definition in the Specification, the construction is to be guided  
9 by how one of ordinary skill would have understood the term. The ordinary  
10 and customary meaning of "personal computer" is a computer built around a  
11 microprocessor for use by an individual. FF 02. Nichtberger's computer is  
12 built around a microprocessor for use by an individual. FF 07. Even if we  
13 take the argument that a kiosk itself is not a personal computer, the  
14 microprocessor and associated circuitry forming Nichtberger's computer  
15 would be a personal computer within the kiosk. Nothing in claim 1 further  
16 specifies the protocols used for information transmitted to and from the  
17 personal computer, so arguments regarding email and internet connections  
18 are simply not commensurate with the scope of the claim. Thus, we agree  
19 with the Examiner that Nichtberger's computer is a personal computer.

20 The Appellants next argue that the coupon in Nichtberger is not a  
21 voucher as in claim 33. Appeal Br. 19. The Appellants offer a definition of  
22 a voucher as "a document that provides supporting evidence for a claim."  
23 Appeal Br. 19. The Specification does not provide a definition. FF 03. The  
24 ordinary and customary meaning of "voucher" is a piece of substantiating  
25 evidence. FF 04. This is consistent with the Appellants' proffered  
26 definition.

1        So, the issue is whether a coupon for a product discount, even a  
2        paperless coupon, resident in a computer, is a document that provides  
3        supporting evidence for a claim. Clearly, a product discount coupon is  
4        evidence for the claim of a product discount. Certainly, documents can be  
5        electronic in nature. Further, a receipt may be printed by Nichtberger for the  
6        user's convenience, identifying the selected coupons. FF 08. This would be  
7        a printed document evidencing the claims for product discounts.  
8        Accordingly, we agree with the Examiner that Nichtberger's coupons are  
9        vouchers and so Nichtberger describes claim 33.

10       The Appellants also argue claims 41, 42, and 44. As the Appellants  
11       point out (Appeal Br. 22), the Examiner made no factual findings as to the  
12       identifying a plurality of product discounts on a basis of a frequency of  
13       usage of tokens by a consumer. We are unable to find any such description  
14       in Nichtberger. Thus, we agree that the Examiner failed to present a prima  
15       facie case of anticipation as to claim 41 and 42.

16       Claim 44 requires using the Internet or an intranet. Both the Internet and  
17       an intranet use the same technological protocol of TCP/IP but each pertains  
18       to a different network domain. The Appellants point out that the Examiner  
19       made no showing that Nichtberger describes an intranet or the Internet, and  
20       no showing of their technology. Appeal Br. 19.

21       The Examiner found that Nichtberger describes a communication link.  
22       The Examiner implied that such a link was part of a LAN, WAN or intranet.  
23       Ans. 6. However, although Nichtberger describes a communications link, it  
24       does not describe the topology or the protocols employed in the link. FF 09.

Thus, we agree with the Appellants that the Examiner failed to present a prima facie case of anticipation for the Internet or intranet of claim 44.

Claims 54, 55, 57, 67, 68, and 70 parallel claims 41, 42, and 44, and so the Examiner failed to present a prima facie case as to those claims as well. The remaining rejection as to the remaining claims stand with the rejection as to the independent claims.

*Claims 34, 47 and 60 rejected under 35 U.S.C. § 103(a) as unpatentable over Nichtberger.*

These claims also require a voucher as with claim 33. The Appellants repeated their argument regarding a voucher from claim 33 *supra*, and we find that argument equally unpersuasive here. The Appellants also argued claims 71-76 (Appeal Br. 22), but these claims are not within the scope of this rejection.

*Claims 72-74 and 76 rejected under 35 U.S.C. § 103(a) as unpatentable over Nichtberger and Barnett.*

Barnett is directed to distributing and generating, at a remote site, product redemption coupons. FF 10. The Appellants argue that there is no reason to combine the references. Appeal Br. 23. But Barnett describes how to implement Nichtberger's coupon computer at a different location. Offering multiple venues for product promotion is and has been a fundamental marketing ploy, known to those of ordinary skill in the product promotion arts.

When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this

leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.

*KSR*, 550 U.S. at 421.

## CONCLUSIONS OF LAW

The Examiner did not err in rejecting claims 32, 33, 35-40, 43, 45, 46, 48-53, 56, 58, 59, 61-66, 69, 71, and 75 under 35 U.S.C. § 102(b) as anticipated by Nichtberger.

The Examiner erred in rejecting claims 41, 42, 44, 54, 55, 57, 67, 68, and 70 and under 35 U.S.C. § 102(b) as anticipated by Nichtberger.

The Examiner did not err in rejecting claims 34, 47 and 60 under 35 U.S.C. § 103(a) as unpatentable over Nichtberger.

The Examiner did not err in rejecting claims 72-74 and 76 under 35 U.S.C. § 103(a) as unpatentable over Nichtberger and Barnett.

## DECISION

To summarize, our decision is as follows.

- The rejection of claims 32, 33, 35-40, 43, 45, 46, 48-53, 56, 58, 59, 61-66, 69, 71, and 75 under 35 U.S.C. § 102(b) as anticipated by Nichtberger is sustained.
- The rejection of claims 41, 42, 44, 54, 55, 57, 67, 68, and 70 under 35 U.S.C. § 102(b) as anticipated by Nichtberger is not sustained.
- The rejection of claims 34, 47 and 60 under 35 U.S.C. § 103(a) as unpatentable over Nichtberger is sustained.

- The rejection of claims 72-74 and 76 under 35 U.S.C. § 103(a) as unpatentable over Nichtberger and Barnett is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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